

**REMARKS**

Please amend claims 1 and 11 as shown on the attached listing of the claims. Therefore, as of this paper, claims 1-20 are remaining in the case and are presented for the Examiner's attention.

Applicants thank Examiner Sugarman for including in the Office Action mailed October 4, 2007 an initialed copy of the Form PTO-1449 sent with Applicants' Information Disclosure Statement. The Applicants also thank the Examiner for indication of allowable subject matter in claims 11-20.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

**Allowable subject matter**

In the Office Action on pages 2- 3 under the heading "Allowable Subject Matter", it was stated that claims 11-20 are allowed, but that claim 11 must be amended to correct for the typographical error. Specifically, step "(4)" of claim 11 as originally filed included the word "interpretably" in the phrase, "... a data file containing information ... in a form that is interpretably by a computer-controlled manufacturing device". After review of the application specification, Applicants note that this same typographical error occurs in 4 locations in the specification text, and therefore submit herewith the amendments to the specification shown above to correct the error. It was stated in the Office Action that "interpretably" was believed to be properly read as "interpreted". However, Applicants respectfully submit that "interpretable" was incorrectly spelled "interpretably", and the amendments submitted herewith have therefore made this correction.

**Claims rejection, 35 U.S.C. §101**

On page 2 of the Office Action mailed October 4, 2007, method claims 1-10 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Although the Applicants do not necessarily agree with the Office's assessment as regards these claims, in the interest of advancing prosecution Applicants have provided herewith an amended claim 1 and respectfully submit that the current

amendment to claim 1 recites sufficient additional features to overcome this rejection. Applicants therefore respectfully **traverse** this rejection, particularly as it may be viewed to apply to currently amended claim 1 and its dependent claims 2-10.

Regarding the rejection under 35 U.S.C. §101 more specifically, it was stated in the Office Action that although the original claims 1-10 appeared useful and concrete, they did not appear to constitute a tangible result. However, Applicants submit that the data file generated in step (4) of claim 1 (as currently amended) is a legally cognizable tangible result, in at least the same fashion that the calculated "final share price momentarily fixed" was held to be a tangible result in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). For this reason, Applicants submit this rejection under 35 U.S.C. §101 is overcome and respectfully request that this rejection be withdrawn.

### **Conclusion**

For at least the reasons stated above, it is respectfully submitted that all of the currently presented claims are in form for allowance. Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. The Commissioner is hereby authorized to charge any other fees which may be required, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

/ Robert A. Ambrose /

Robert A. Ambrose  
Reg. No. 51,231  
(678) 415-3690

Date: January 4, 2008

CIBA Vision Corporation  
Patent Department  
11460 Johns Creek Parkway  
Duluth, GA 30097-1556